

Remarks

Claims 1 and 3-20 are currently pending and stand rejected. Claims 1, 3-10, 18 and 20 stand rejected under 35 USC §112 as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 3-20 are rejected under 35 USC §103(a). Claims 1, 5, 7, 10, 11, 18 and 20 have been amended. Applicants assert that the claims are now in condition for allowance as set forth more fully below.

Provisional Double Patenting

While Applicants do not concede the correctness of the double-patenting rejection since the claims of 09/966,806 refer to an input manager that is patentably distinct from the present claims, Applicants have included a terminal disclaimer to expedite an allowance of the present application.

112 Rejections

Claims 1, 3-10, 18 and 20 have been rejected under 35 UCS §112 as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “the accuracy” had been deleted.

In claim 5, the term “step” has been deleted.

In claim 10 the differentiation between a first database and a Tax TAR database has been included in amended base claim 1 which therefore extends to claim 10 as well.

In claim 18, “the database” in line 1 has been clarified as being a “second database”.

In claim 20, the terms “the accuracy” and “the basis” have been deleted. The term “the tax” has been changed to “a tax”.

Amended claims 1, 5, 10, 18 and 20 now are definite under §112. Dependent claims 3-4 and 6-9 depending from claim 1 are now definite for the same reasons and comply with 35 USC §112. As such, the rejections of claims 1, 5, 10, 18 and 20 asserted by the Office Action under §112 should be withdrawn. Dependent claims 3-4 and 6-9 depend from allowable amended claim 1 and are also allowable for the same reasons.

103 Rejections

Claims 1 and 3-20 stand rejected under 35 USC 103(a) as being unpatentable over Marchbanks (US Pat 6,266,401) in view of Heindel (US Pat 6,304,857) and Examiner's Official Notice. Applicants respectfully traverse these rejections.

The Office Action has rejected claims 1 and 3-20 by stating that Marchbanks discloses most of the elements but fails to disclose utilizing an outsourced billing entity to generate "hold" bills and carry out the final distribution of bills, the specific step of performing a recalculation for verification purposes and the displaying of worksheet information. The Office action points to Heindel as disclosing the outsourcing the creation of "hold bills" and final bill distribution. However, the Office Action has taken Official Notice, without citing specific prior art, that it is well known to perform recalculations to determine if prior calculations are accurate and to display database information in the form of a worksheet. The Office Action (Page 5) relies on Heindel's teaching of outsourcing the preparation of bills stating that it would have been obvious to outsource recalculation of taxes in Marchbanks based on the combination of Official Notice and Heindel. Applicants respectfully traverse these rejections.

Claims 1 and 3-10

Amended claim 1 recites a method of verifying taxes on a batch of customer telecommunications bills initially generated, and ultimately to be sent out, by an entity other than a telecommunications service provider, comprising the steps of downloading, from a mainframe computer, to a local server ...billing data associated with customer accounts...wherein the billing data includes prebill data that can be downloaded on a day of verification and demand print data that can be down loaded prior to the corresponding prebill data, ...providing an option for immediately calculating calculated tax results without displaying predetermined categories of information stored in the database,... independently from the mainframe computer, calculating calculated tax results for each

of several charges in the billing data utilizing... local tax rates and surcharge information populated in a Tax TAR database...and resolving errors on the customer bill detected from the comparing.

Neither of the cited references, individually or in combination, teach or suggest any of the elements recited above from amended claim 1 specifically, the separate downloading of prebill data that can be downloaded on a day of verification and demand print data that can be down loaded prior to the corresponding prebill data, an option to calculate taxes without displaying predetermined information in the database, calculating taxes independently of the mainframe computer using tax rate and surcharge information from a Tax TAR database or resolving any tax errors discovered as the result of the calculation and the comparing steps. A reference must provide an explicit or implicit suggestion, teaching or motivation in order to be §103 prior art. See, *In Re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q2D (BNA) 1614 (Fed. Cir. 1999) (Placing a pumpkin face on an orange trashbag not obvious under 35USC§103 without finding of suggestion, teaching or motivation in the reference).

Marchbanks teaches a telecommunication billing system that includes bill processing and invoice verification in which the process acquires the authorized customer profile and applies all monthly account-level recurring, non-recurring and usage charges. It then discounts and determines taxes in a second process. Marchbanks checks the integrity of and corrects raw data that it receives from a service provider when possible (Col. 6, l. 50-62). Importantly, the Marchbanks system only verifies its **own** processing, including taxes, by reviewing sampling invoices for each customer profile. (Col. 4, l. 42-46). The checking and verification processes appear to be only data transfer integrity verification and not substantive data accuracy checks by recalculation.

Marchbanks is not concerned with verifying the accuracy of the original tax calculations by recalculating taxes on the separate local server independently from the mainframe computer so that any latent or inherent calculation errors in the billing system mainframe can be detected. Neither is Marchbanks nor Heindel concerned with resolving tax calculation errors after comparing a mainframe tax calculation and an independent calculation.

Heindal teaches a set of software tools for a biller (i.e. a telecommunications service provider) to create and design a customized billing system in which the biller provides the actual billing data and the invoice format to a third party to then, in turn, distribute electronically. (Abstract). In Heindal, the biller previews a sample of the bills provided by the third party but that is a mere review of the appearance of the bills as they will appear to the customer (Col. 9, l.17-20).

Heindal is not concerned with verifying the accuracy of the original tax calculations by recalculating taxes on the separate local server independently from the mainframe computer so that any inherent calculation errors in the mainframe can be detected. Heindal is also not concerned with resolving tax calculation errors. Heindal receives billing information in batch format (Col.5, l. 28-32) from the Biller and does not recalculate any of the billing information.

Furthermore neither Heindal nor Marchbanks teaches either an option to recalculate taxes without displaying a tax calculation worksheet or of separately receiving and processing demand bill information prior to receiving the corresponding prebill information.

Further still, Applicants assert that Office Action's Official Notice of the verification of taxes and the use of a worksheet to process and compare the tax data constitutes hindsight and is improper. See, *In Re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)(examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]); MPEP 2143, 2143.01. If taxes were calculated incorrectly in the first instance by a third party billing system, Marchbanks' self review would merely verify that the taxes were indeed included on the final invoice as erroneously reported. Because Marchbanks teaches that the IPS module checks itself, it is actually teaching away from the use of a separate server which recalculates taxes independently and then compares it information received from the billing third party or mainframe. Similarly, the third party system in Heindel merely accepts data from a biller and delivers it electronically. As such, even if the Official Notice was not hindsight, there is no suggestion or teaching to utilize an independent calculation. A suggestion or motivation to modify a single reference is required for an obviousness rejection. See. *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d

1349, 55 U.S.P.Q.2D (BNA) 1927 (Fed. Cir. 2000). Applicants respectfully request that a reference be provided teaching or suggesting independent recalculation of taxes and the display of database information in the form of a worksheet..

Therefore, the cited references and the official notice, singly or in combination, fail to disclose or suggest each and every element of amended claim 1. Furthermore, the cited references appear to teach away from the Official Notice. As such, claim 1 is allowable over the cited references and Official Notice for at least these reasons. Dependent claims 3-10 depend from allowable amended independent claim 1 and are also allowable for at least the same reasons.

Claims 11-19

The Office Action rejects independent claims 11 under 35 USC 103(a) by taking Official Notice, in combination with Marshbanks and Heindel, that the calculated tax result being independently calculated by the second entity (or “service provider”) and comparing the calculated tax result displayed in the worksheet with the hold bill taxes are old in the art. Applicants respectfully traverse the rejection.

Amended independent claim 11 recites similar elements to those recited in amended claim 1. Specifically, amended claim 1 recites, in pertinent part, a method of verifying hold bill taxes on account charges on a customer hold bill, the hold bill being a bill that is scheduled to be sent as a customer bill to a customer by a first entity on behalf of a second entity the first entity having independently calculated the hold bill taxes, the method comprising the steps of...automatically applying the tax rate information to the account charges and storing a calculated tax result, the calculated tax result being independently calculated by the second entity, ...comparing the calculated tax result displayed in the worksheet with the hold bill taxes appearing on the hold bill and when the calculated tax result displayed in the worksheet matches the hold bill taxes, the second entity authorizing the first entity to print and to send the hold bill as a customer bill.

For similar reasons as discussed above in relation to amended claim 1, Applicants assert that Office Action’s Official Notice of the independent verification of taxes and the use of a worksheet to process and compare the tax data constitutes hindsight and is

improper. See, *In Re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)(examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); MPEP 2143, 2143.01.

Therefore, the cited references and the official notice, singly or in combination, fail to disclose or suggest each and every element of amended claim 11 such that this claim is allowable over the cited references and Official Notice for at least these reasons. Dependent claims 12-19 depend from allowable amended independent claim 11 and are also allowable for at least the same reasons.

Claim 20

The Office Action rejects independent claim 20 by taking Official Notice that the service provider in the modified scenario would download data and perform a recalculation for verification purposes, the recalculated amount is then compared to the initial calculation and if equal the hold bill is verified. Applicants respectfully traverse the rejection.

Amended independent claim 20 recites similar elements to those recited in claim 1. Specifically, amended claim 20 recites, in pertinent part, a method of verifying tax charges on a hold bill generated for a customer account by an outsourced entity, the hold bill being one that is scheduled to be sent directly to the customer by the outsourced entity as a customer bill upon verification by an entity providing service, other than billing service, the method comprising the steps of downloading data, including customer charges, to the entity providing service, other than billing service, to a local server..., automatically calculating a tax for the customer charges subject to taxation..., comparing the calculated tax results displayed in the worksheet to the tax charges on the hold bill, wherein the hold bill is generated on a mainframe computer operated by the outsourced entity, the tax charges on the hold bill are independently calculated by the outsourced entity the local server is operated separately from the mainframe computer by the entity providing service, other than billing service, and the entity providing service, other than billing service, independently calculates the calculated tax results, and wherein when the calculated tax results match the tax charges on the hold bill, authorizing the outsourced

entity, by the entity providing service, other than billing service, to send the hold bill as a customer bill to the customer.

For similar reasons as discussed above in relation to amended claim 1, Applicants assert that Office Action's Official Notice of the verification of taxes and the use of a worksheet to process and compare the tax data constitutes hindsight and is improper. See, *In Re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)(examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]); MPEP 2143, 2143.01.

Therefore, the cited references and the official notice, singly or in combination, fail to disclose or suggest each and every element of amended claim 20 such that this claim is allowable over the cited references and Official Notice for at least these reasons.

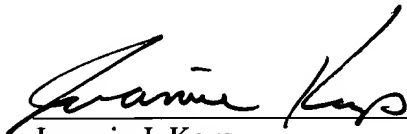
Conclusion

Applicants assert that the application including claims 1 and 3-20 is now in condition for allowance. Applicants request reconsideration in view of the amendments and remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees beyond the terminal disclaimer fee are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

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